

REMARKS

In this Reply, Applicants have amended claims 4, 6, 8, 14, 55-60, 63, 64, 66, 68, 74, 115-122, 126, 128, 130, 136, 177-182, and 184, to recite features inherent in the original words of the claims. Applicants have also cancelled claim 65 without prejudice or disclaimer. Claims 4-20, 55-64, 66-80, 115-122, 126-142, and 177-184 are currently pending.

In the Office Action¹, the Examiner rejected claims 4-20, 55-80, 115-122, 126-142, and 177-184 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,654,779 to Tsuei ("Tsuei"). For the reasons that follow, Applicants respectfully traverse these rejections.

To establish that *Tsuei* anticipates Applicants' claims under 35 U.S.C. § 102(e), the Examiner must show that *Tsuei* discloses each and every element of Applicants' claims, either expressly or inherently. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Furthermore, the identical disclosure "must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Because *Tsuei* fails to disclose each and every element of each claim, as amended, Applicants respectfully request that the rejections under 35 U.S.C. § 102(e) be withdrawn.

For example, independent claim 4, as amended, recites a method for providing an electronic change of physical address service from an old physical address of a customer to a new physical address of the customer, comprising, *inter alia*, "providing a

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

user interface at a change of address server for the customer to enter change of physical address information; receiving the change of physical address information at the change of address server via a network; creating a first change of address record at the change of address server representing the change of physical address information;" and "processing, by the forwarding service unit, the second change of address record received from the service center electronically to automatically redirect physical mail addressed to the old physical address of the customer to the new physical address of the customer."

Tsuei does not disclose the above-recited combination of features, among others, at least because *Tsuei* contains no teachings related to physical addresses and physical mail. To give a particular example, *Tsuei* fails to disclose or suggest a "forwarding service unit" that "automatically redirect[s] physical mail addressed to the old physical address of the customer to the new physical address of the customer," as recited in amended claim 4, or anything remotely similar.

Instead, *Tsuei* discloses an e-mail address management system ("EAMS") (Fig. 3; col. 6, lines 16-20). An e-mail address change may be registered with the EAMS by a recipient or by an internet service provider ("ISP"). (Col. 10, lines 12-20). Once the e-mail address change is registered with the EAMS, the EAMS may send a new e-mail address over the internet back to the sender ISP so that the sender ISP can forward the e-mail to the recipient's new e-mail address. (Col. 10, lines 12-37). *Tsuei* is concerned solely with e-mail, and discloses no processes, systems, or structures (such as, e.g., computer-controlled sorting machines) capable of redirecting, forwarding, relabeling, or otherwise handling physical mail that is being sent to a physical address (such as, e.g.,

a person's home address). Consequently, *Tsuei* does not teach or suggest the subject matter of claim 4, as amended.

For at least the foregoing reasons, *Tsuei* does not teach each and every claim element recited in amended independent claim 4, *Tsuei* does not anticipate amended claim 4, and claim 4 is allowable over the references of record. Although of different scope, amended independent claims 6, 8, 14, 55, 63, 66, 68, 74, 115, 126, 128, 130, 136, and 177 recite features similar to those of claim 4. Consequently, *Tsuei* does not anticipate independent claims 6, 8, 14, 55, 63, 66, 68, 74, 115, 126, 128, 130, 136, and 177, and these claims are also allowable over the references of record.

In addition independent claims 55, 115, and 177 recite at least one additional element not taught by *Tsuei*—namely “providing an additional service to the customer to assist the customer in changing from the old physical address to the new physical address,” as recited in amended claim 55 (with similar elements recited in amended claims 115 and 177). Again, *Tsuei*’s email forwarding system simply contains no teachings related to services that assist in changing from one physical address to another physical address.

Dependent claims 5, 7, 9-13, 15-20, 56-62, 64, 67, 69-73, 75-80, 116-122, 127, 129, 131-135, 137-142, and 178-184 incorporate the features of the independent claims from which they depend. Consequently, *Tsuei* fails to disclose every element of these dependent claims, and they are allowable over the references of record at least by virtue of their dependence from allowable independent claims. Dependent claims 5, 7, 9-13, 15-20, 56-62, 64, 67, 69-73, 75-80, 116-122, 127, 129, 131-135, 137-142, and 178-184 are also allowable by virtue of reciting additional features not taught nor

suggested by *Tsuei*. For one example, dependent claims 58, 118, and 180 recite "mailing a mail piece to the designated individual or company describing the customer's change of physical address." *Tsuei*'s email forwarding system simply contains no teachings related to mailing a mail piece or a customer's change of physical address.

Finally, Applicants note that the rejection of claims 5, 7, 9-13, 15-19, 56-62, 64, 65, 67, 69-73, 75-79, 116-122, 127, 129, 131-135, 137-141, and 178-184 on page 4 of the Office Action is improper, inadequate, and based on a false premise. The Office Action states that these claims "do not further limit the inventive concept disclose[d] in claim 4." This statement is false because each of the listed claims recited additional elements that further limit their base claims. For example, dependent claim 5 recites "The method of claim 4, wherein forwarding the second change of address record includes: uploading the second change of address record to the forwarding service unit." Thus, dependent claim 5 adds the additional step of "uploading" to the method of claim 4. Claim 5 obviously "further limits" claim 4 because one cannot infringe claim 5 without performing the recited "uploading," while the converse is not true--one can infringe claim 4 without performing the "uploading" recited in claim 5. The same is true of the other listed dependent claims.

This rejection is improper and inadequate because the Examiner has not articulated any basis, reasoning, citation, or facts supporting the rejection of claims 5, 7, 9-13, 15-19, 56-62, 64, 65, 67, 69-73, 75-79, 116-122, 127, 129, 131-135, 137-141, and 178-184. 37 CFR § 1.104 (c)(2); M.P.E.P. § 706. "The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the

earliest opportunity." M.P.E.P. § 706. In the Office Action, the Examiner relies solely on the unsupported, conclusory statement that "the[] limitations are clearly taught in Tsuei's disclosure." This statement violates the M.P.E.P. and patent rules and deprives Applicants of a fair chance to respond to the rejection. Applicants cannot intelligently reply and provide evidence of patentability because the Examiner's single conclusory statement does not articulate any specific basis in the prior art or other reasons why the claims are rejected.

Unlike the Examiner, Applicants have been unable to identify where these claim limitations are "clearly taught in Tsuei's disclosure." Because the locations of the teachings are clear to the Examiner, the Examiner should be able to easily provide citations to the exact columns and line numbers of Tsuei that disclose each claim element of claims 5, 7, 9-13, 15-19, 56-62, 64, 65, 67, 69-73, 75-79, 116-122, 127, 129, 131-135, 137-141, and 178-184. Accordingly, should the Examiner maintain the rejections of these claims, Applicants respectfully request that the Examiner provide those exact citations in the next Office Action, so that Applicants may have a fair chance to respond to these rejections.

For at least the foregoing reasons, Applicants request the withdrawal of the 35 U.S. C. § 102(e) rejections of claims 4-20, 55-80, 115-122, 126-142, and 177-184, and the allowance of these claims.

CONCLUSION

The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statements are

identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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